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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,238	12/12/2005	Yoshiaki Iwata	2005_1886A	2533
52349 7590 03/02/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
DAZENSKI, MARC A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,238

Applicant(s)

IWATA ET AL.

Examiner

MARC DAZENSKI

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 12-12-2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. **Claims 17-18** both define a computer program embodying functional descriptive material. However, the claim does not define a computer-readable medium or computer-readable memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the

medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on “computer-readable medium” or equivalent; assuming the specification does NOT define the computer readable medium as a “signal”, “carrier wave”, or “transmission medium” which are deemed non-statutory (refer to “note” below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Note:

A “signal” (or equivalent) embodying functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, “signal” is a form of energy, in the absence of any physical structure or tangible material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by

Akamatsu et al (US Patent 7,224,886), hereinafter referred to as Akamatsu.

Regarding **claim 1**, Akamatsu discloses a method of using AV devices and AV device system. Further, Akamatsu discloses an AV device system comprising integrated receiver/decoders (100a), (100b) and recording device (110), which reads on the claimed, "a recording device," as disclosed at column 7, lines 64-67; the apparatus comprising:

user interface section (101) for exchanging signals for setting and displaying the timer reservation with the operator using an input designation device, which reads on the claimed, "a receiving unit operable to receive, from a user, a record instruction specifying a processing content for recording a broadcast program," as disclosed at column 8, lines 16-20;

a device which inquires of the timer reservation section of the related device whether or not the related device is available for use as reserved, "a collecting unit operable to collect second capability information relating to a recording capability of one or more external devices," as disclosed at column 17, lines 30-34;

integrated receiver/decoder (2210) extracts a recording device capable of recording the program from among the devices connected on the bus (10), which reads on the claimed, "a judging unit operable to judge, with reference to prestored first capability information relating to a recording capability of the recording device, whether the recording device is capable of recording in accordance with the processing content," as disclosed at column 20, lines 33-35;

recording device control section (119) for controlling the operation of the recording device (110) which records programs based upon reservation data, which

reads on the claimed, "a recording unit operable, if judged in the affirmative, to receive and record the broadcast program in accordance with the processing content," as disclosed at column 8, lines 50-52 and column 20, lines 33-35; and,

a communication interface section (2002) for communicating data and control signals to other devices through a bus, and integrated receiver/decoder (2210) which selects a capable recording device based on recording medium capacity and timer reservation, which reads on the claimed, "a selecting unit operable, if judged in the negative, to select an external device capable of recording in accordance with the processing content, based on the collected second capability information; and a communication unit operable to convey the record instruction to the selected external device," as disclosed at column 18, lines 2-5; column 20, lines 33-45.

Regarding **claim 2**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, Akamatsu discloses reservation data (2100) which includes a recording mode, a program title, and a reserved time (starting/ending time), which reads on the claimed, "wherein the processing content includes information specifying an image quality," as disclosed at column 18, lines 33-36 and exhibited in figure 21;

record execution information (2400) which includes a recording mode, a program title, and a reserved time (starting/ending time), which reads on the claimed, "the first capability information includes information showing an image quality at which the recording device is capable of recording," as disclosed at column 19, lines 61-67 and exhibited in figure 24;

record execution information (2300) which includes a recording mode, a program title, and a reserved time (starting/ending time), which reads on the claimed, "the second capability information includes information showing an image quality at which the one or more external devices are capable of recording," as disclosed at column 19, lines 28-33 and exhibited in figure 23;

integrated receiver/decoder (2210) extracts a recording device capable of recording the program from among the devices connected on the bus (10) based upon whether the designated reserved time is available for use and then inquires as to whether the medium has a capacity required for recording the designated program, which reads on the claimed, "the judging unit judges, with reference to the first capability information, whether the recording device is capable of recording at the specified image quality, and the selecting unit selects an external device capable of recording at the specified image quality based on the second capability information, if judged in the negative," as disclosed at column 20, lines 25-45 and exhibited in figure 25.

Regarding **claim 3**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 2 above.

Regarding **claim 4**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 2 above.

Regarding **claim 5**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 2 above.

Regarding **claim 6**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, Akamatsu discloses integrated receiver/decoder (2210) extracts a recording device capable of recording the program from among the devices connected on the bus (10) based upon whether the designated reserved time is available for use and then inquires as to whether the medium has a capacity required for recording the designated program, which reads on the claimed, "a requesting unit operable to request the external device to which the communication unit conveyed the record instruction, to send the recorded broadcast program; and a second recording unit operable to receive the broadcast program transmitted from the external device in response to the request, and to record the received broadcast program to a recording medium," as disclosed at column 20, lines 25-45 and exhibited in figure 25.

Regarding **claim 7**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 6 above.

Regarding **claim 8**, Akamatsu discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 6 above.

Regarding **claim 9**, Akamatsu discloses a method of using AV devices and AV device system. Further, Akamatsu discloses an AV device system comprising

integrated receiver/decoders (100a), (100b) and recording device (110), as well as a system with various devices connected by a bus, which reads on the claimed, "a proxy-recording device," as disclosed at column 7, lines 64-67; column 17, lines 12-13; and exhibited in figure 17; the apparatus comprising:

integrated receiver/decoder (2210) which extracts a recording device capable of recording the program from among the devices connected on the bus (10), which reads on the claimed, "a capability-disclosing unit operable to convey, to an external device, capability information relating to a recording capability of the proxy-recording device," as disclosed at column 20, lines 33-35;

the recording devices are inquired whether the designated reserved time is available for use, and extracts any one of them available for use, then inquires the devices regarding medium capacity, and from among these recording devices a related device for recording the program at the time of executing the reservation is determined, which reads on the claimed, "a proxy-receiving unit operable to receive, from the external device, a record instruction specifying a processing content for recording a broadcast program; and a proxy-recording unit operable to receive and record the broadcast program to a recording medium, in accordance with the record instruction," as disclosed at column 20, lines 35-45 and exhibited in figure 25.

Regarding **claim 10**, Akamatsu discloses everything claimed as applied above (see claim 9). Further, Akamatsu discloses record execution information (2300) which includes a recording mode, a program title, and a reserved time (starting/ending time), which reads on the claimed, "the capability information includes information showing an

image quality at which the proxy-recording device is capable of recording, the processing content includes information specifying an image quality," as disclosed at column 19, lines 28-33 and exhibited in figure 23; and,

integrated receiver/decoder (2210) extracts a recording device capable of recording the program from among the devices connected on the bus (10) based upon whether the designated reserved time is available for use and then inquires as to whether the medium has a capacity required for recording the designated program, which reads on the claimed, "the proxy-recording unit performs the recording at the specified image quality," as disclosed at column 20, lines 25-45 and exhibited in figure 25.

Regarding **claim 11**, Akamatsu discloses everything claimed as applied above (see claim 9). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 10 above.

Regarding **claim 12**, Akamatsu discloses everything claimed as applied above (see claim 9). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 10 above.

Regarding **claim 13**, Akamatsu discloses everything claimed as applied above (see claim 9). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 10 above.

Regarding **claim 14**, Akamatsu discloses everything claimed as applied above (see claim 9). Further, Akamatsu discloses communication interface section (2002) for communicating data and control signals to other devices through a bus, which reads on

the claimed, "a transmission unit operable to send the broadcast program recorded on the recording medium to the external device," as disclosed at column 18, lines 2-5.

Regarding **claim 15**, the examiner maintains the claim is the corresponding method to the apparatus of claim 1, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 1 above.

Regarding **claim 16**, the examiner maintains the claim is the corresponding method to the apparatus of claim 9, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 9 above.

Regarding **claim 17**, the examiner maintains that the claim is the corresponding computer program executing the method of claim 15, and the limitations of the claim are rejected in view of the explanation set forth in claim 15.

Regarding **claim 18**, the examiner maintains that the claim is the corresponding computer program executing the method of claim 16, and the limitations of the claim are rejected in view of the explanation set forth in claim 16.

Regarding **claim 19**, the limitations of the claim are rejected in view of the explanation set forth in claim 1 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/MARC DAZENSKI/
Examiner, Art Unit 2621